

## Remarks

## I.

The Standard Of Appellate Review For Patent Office Examination, Requires Examiner's Findings Be Supported By Substantial Evidence In the Record

Board review of Examiner's rejection is made under the standard of substantial evidence, as set forth below. Appellants' Brief contends Examiner's finding of fact are unsupported by substantial evidence in the record and fails to meet the examination standard of substantial evidence. Examiner's grounds for rejection must be reversed when factual findings underlying Examiner's stated grounds of rejection are not supported by concrete evidence in the record. *In re. Zurko* 258 F.3d 1379 (Fed. Cir) 2001, at 1386. The substantial evidence standard of review for a Patent Office rejection requires complete record of all of the facts and reasoning that were used or should have been used, in support of the arguments rejecting Appellants' claims and rebutting Appellants' arguments for patentability.

The substantial evidence standard requires a finding of such relevant evidence as a reasonable mind might accept as adequate to support a conclusion.

*id.*, at 1384.

Basic knowledge or common sense, which is not based on any evidence in the record, lacks substantial evidence support.

*id.* at 1385.

Patent Office expertise is restricted to the support of conclusions "as to peripheral issues," However,

With respect to core factual findings in a determination of patentability ... the [Examiner] cannot simply reach conclusions based on its own understanding or experience -or on [Examiner's] assessment of what would be basic knowledge or common sense. Rather, the [Examiner] must point to some concrete evidence in the record in support of.. [Examiner's] findings.

*Id* at 1385, 1386.

Required in support of a rejection is concrete evidence in the record. *In re. Zurko* 258 F.3d 1379 (Fed.

*Cir) 2001, at 1386.*

This standard for all Patent Office examination review is hereinafter referred to as the "Substandard of Substantial Evidence".

## II.

### Claims 33 to 58 Are Allowable

Examiner's Answer to the Remand from the Board of Appeals, has cited Fowble and Pratt, as prior art. Applicants contend Fowble or Pratt, separately or in combination, do not anticipate or make obvious, any recitation of the claim 33 to 58, in this case

## A.

### Claims 33 to 58 Are Not Anticipated By Fowble

#### a.

#### The Limits To The Fowble Disclosure

Fowble is limited to a finger protector to protect the finger, without any disclosure, teaching, or showing, of protection for the finger pad. However, Fowble does describe the protector being of sufficient length to cover the entire finger. Page 1, lines 86 - 88. Fowble discloses the material may be made "more rigid," without disclosing any standard or reference from which one skilled in the art may understand exactly "how" rigid Fowble recommends or teaches the material may be except by telling us it should be rigid but not rigid to resist bending. Page 1, lines 32 - 41. To the extent of Fowble's disclosure, there is nothing to show, teach, or describe, to one skilled in the art, what Fowble means by "rigid," or how "thick" or "rigid" to make the protector except it should be "thicker and more rigid than heretofore employed". Page 1, lines 33 - 36.

Accordingly, any reference to Fowble disclosing a "shield made of rigid material," is not supported by record based facts, fails the examination standard of substantial evidence, and is meaningless in the context of the record claims. Fowble's disclosure is limited to a protector designed to fit over the finger and made of a "thicker" or more rigid" material that Fowble says was used previously but without disclosing what that previously used material is or was. Accordingly, Fowble does not disclose what kind of material is used, or what it does, except to prevent "galling" or "chafing" of the fingers. Page 1, lines 9 - 12.

Fowble is directed to prevent galling or chaffing of the fingers. Page 1, lines 9-12. The plain meaning of chaffing or galling, is to irritate or wear away by rubbing. Prevention of chaffing or galling does not require, or teach or describe a fixed relation of the protector of Fowble with the finger pad. The teaching and disclosure of Fowble is the protector may be positioned over the finger in any relation where the protector body is interposed between any part of the finger used to hold or grip the object and the object. The part of Fowble identified by Examiner as "strap 5," is not described except by reference to the drawing. Fowble describes the protector as having an open end to form an outlet for for grit and sand liable to find its way between the protector and finger. Page 1, lines 67-74. This description of the protector open to allow accumulated grit or sand to leave through the "opening e to form an outlet, implies a loose fit where the Examiner identified "strap 5," does not provide any function except to prevent the loose fitting protector from falling away from the bottom of the finger, opposed to the top part intended to contact what Examiner has identified as "strap 5." The foregoing is the limit of the Fowble disclosure of a "strap 5," and there is no disclosure beyond that limited disclosure of a strap or ring or any other means to hold the protector in a fixed or any other intended relationship with the finger except a loose fit limited to the protection of the fingers from lateral forces along the surface of the protector which may gall or chafe the finger.

Fowble makes no disclosure of any "raised surface," or "limit means," for limiting the depth of insertion of the finger pad shield into the finger hole of a bowling ball. The disclosure of Fowble of what Examiner identifies as "strap 5," is nothing more than a part of the protector, with its surface in line with the rounded exterior of the protector, and as described above.

The Examiner asserted "strap 5," can be seen by inspection as not a "raised surface," or shown by Examiner by record facts as "capable of functioning as a 'limit means.'

In summary, Fowble's disclosure has no teaching or suggestion or disclosure of the structure of the material used in the disclosed protector.

While Fowble does teach contact between the finger and the finger protector, Fowble only teaches a general area of possible contact or contact subject to change due to use. There is no disclosure in Fowble of a "contact area," or a "fastener," to hold the finger pad in a fixed relationship with the

finger pad.

At best, Fowble discloses an area where the finger pad does not necessarily or always contact the protector in a fixed relationship with a contact area, because the Fowble protector is disclosed as a loose fitting device, worn with enough clearance between the protector and the finger to allow sand and grit to accumulate and fall out, without intercession of the wearer.

The force of interest in Fowble and which the Fowble device is intended to prevent from galling or chaffing the wearer, as disclosed in Fowble, is a lateral force along the surface of the protector and no relation is shown, taught or described in Fowble of that force and any "contact area," whether explicit or implicit

Fowble makes no disclosure of any "raised surface," or "limit means for limiting the depth of insertion of the finger pad shield into the finger hole of a bowling ball. The disclosure of Fowble of what Examiner identifies as "strap 5," is nothing more than a part of the protector, as described above.

b.

Fowble Does Not disclose, Teach, or Describe, Any Recited Element In Claims 33 to 57

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim.

MPEP §2131 Anticipation - Application of

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.

MPEP §2112 Requirements of Rejection Based on Inherency; Burden of Proof

Functional recitations in a claim are premissible.

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is

nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. In re Swinehart, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. Whether or not the functional limitation complies with 35 U.S.C. 112, second paragraph is a different issue from whether the limitation is properly supported under 35 U.S.C. 112, first paragraph or is distinguished over the prior art.

(Underlining Added)

MPEP §2173.05(g) Functional Limitations

The limited disclosure of Fowble, as shown in section a., above cannot anticipate any the following elements recited in claims 33 to 58.

With regard to the recited elements of Claim 33, Fowble does not disclose or teach,

- a contact area located proximate said open end and positioned relative to said open end to receive a finger pad in said contact area;
- a second surface is opposed to said first surface;
- the finger pad shield is adapted for insertion into the finger hole of a bowling ball and to place said second surface in contact with a bowling ball finger hole; and
- the finger pad shield including a fastener to hold said contact area in a fixed relationship against a finger pad; wherein a force produced in the release and lifting of the bowling ball, is spread over said contact area.

With regard to claims 34, 35, and 36, dependent from claim 33, Fowble does not disclose a fastener recited as a strap or as adjustable, or as a ring.

With regard to Claim 37, Fowble does not show a the protector attached to "glove finger enclosure."

With regard to claims 38 and 39, Fowble does not show,

the finger pad shield a raised surface for contacting the surface of a bowling ball, and

the raised surface is located proximate said open end [of the finger pad shield] and adapted to limit the depth of insertion of said finger pad shield into the finger hole of a bowling ball.

With regard to claim 40, Fowble does not show,

the finger pad shield is substantially rigid to resist deformation, from a force produced when a maximum natural force is applied through a finger hole of said bowling ball, to lift and rotate said bowling ball at its release, to spread said force produced, over said contact area.

(Underrlining added.)

With regard to claim 41, Fowble does not show, at least one fastener to hold said contact area in a fixed relationship with a finger pad.

With regard to claim 42, Fowble does not show,

the maximum natural force is in a range within the limit of muscular skeletal development

With regard to claim 43, Fowble does not show where or how the finger pad shield is adapted to spread said force produced over said contact area, substantially uniformly.

With regard to claim 44, Fowble does not show a glove finger enclosure and said finger pad shield is attached to said glove finger enclosure.

With regard to claim 45, Fowble does not shown a finger pad shield with a raised surface extending

away from said finger pad shield and said contact area and adapted to contact the surface of a bowling ball; and limit the depth of inscription of said finger pad shield into the finger hole of a bowling ball.

Claims 46 to 58 are recited in means plus function language, under 35 U.S.C. 112, Paragraph 6 and Fowble shows none of the recited functions in these claims.

B.

Claims 33-58 are not obvious under 35 U.S.C. 103, over Fowble in view of Pratt

a.

The Limits Of the Pratt Disclosure

The disclosure of Pratt is limited to a glove with a finger grip insert. The inserts are resilient for use in picking up coins. See Pratt disclosure.

Pratt teaches away from a rigid insert or any insert which protects the finger from a force against the finger pad, as the glove tips must be tactilely resilient so the user can feel coins, the force of the coins.

b.

Claims 33-58 are not obvious over Fowble in view of Pratt

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or

implicitly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP § 2144 - § 2144.09 for examples of reasoning supporting obviousness rejections.

Manual of Patent Examining Procedure (MPEP) §2142 *Legal Concept of Prima Facie Obviousness*

The Prior Art Must Suggest The Desirability Of The Claimed Invention

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." In re Roufflet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

Id. §2143.01 Suggestion or Motivation To Modify the References

All Claim Limitations Must Be Taught or Suggested

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending therefrom is non-obvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Id. §2143.03 All Claim Limitations Must Be Taught or Suggested

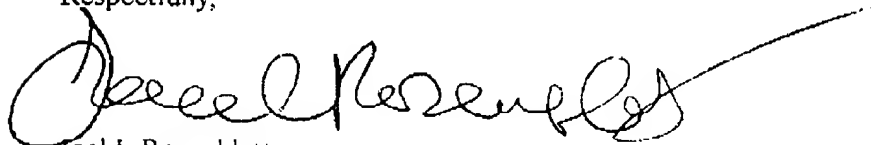


There is no teaching or suggestion in Fowble or Pratt of combining the flexible inserts of Pratt into the protector of Fowble intended to be of vulcanized rubber to resist the lateral chaffing or galling forces, along the finger surface. Pratt's inserts are flexible to be tactilely responsive to the feel of coins in response to the force of the finger against the coins.

Summary

Claims (New) 33-58 are not anticipated or obvious, by Fowble or Pratt, individually or in any combination, and allowance of these claim is requested.

Respectfully,



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